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EWB
Paper No. 21

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re National Semiconductor Corporation

Serial No. 75/607,525

Veronica Colby Devitt of Thelen Reid & Priest L.L.P.

Gina M. Fink, Trademark Examining Attorney, Law Office
103 (Michael Hamilton, Managing Attorney).

Before Simms, Seeherman and Hanak, Administrative
Trademark Judges.

Opinion by Hanak, Administrative Trademark Judge.

National Semiconductor Corporation (applicant) seeks
to register in typed drawing form WEBPAD for "wireless
handheld computers for accessing a global computer
network." The intent-to-use application was filed on
December 15, 1998.

The Examining Attorney has refused registration on
the basis that applicant's mark, as applied to
applicant's goods, is merely descriptive pursuant to
Section 2(e)(1) of the Trademark Act.

When the refusal to register was made final, applicant appealed to this Board. Applicant and the Examining Attorney filed briefs. Applicant did not request a hearing.

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A mark is merely descriptive pursuant to Section 2(e)(1) of the Trademark Act if it immediately conveys information about a significant quality or characteristic of the relevant goods or services. In re Gyulay, 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir. 1987); In re Bed & Breakfast Registry, 791 F.2d 157, 229 USPQ 818, 819 (Fed. Cir. 1986). In order to be held merely descriptive, a term need not immediately convey information about all of the significant qualities or characteristics of the relevant goods or services. A term is merely descriptive if it immediately conveys information about "one of the qualities" of the relevant goods or services. Gyulay, 3 USPQ2d at 1010.

There is no dispute that the two individual components of applicant's mark -- namely, "web" and "pad" -- are, taken individually, merely descriptive of applicant's "wireless handheld computers for accessing a global computer network." In this regard, reference is

made to the following statements made by applicant at pages 1 and 2 of its Motion for Reconsideration:

"Applicant admits that the prefix of its mark refers to the World Wide Web. Applicant has also acknowledged that the suffix is an acronym for Personal Access Device. The only issue on appeal and on this Motion

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for Reconsideration is: Whether WEBPAD, a composite of two descriptive terms, creates a unitary mark with a separate non-descriptive meaning." Reference is also made to page 1 of applicant's brief where applicant makes the following statement: "The only issue to be determined on appeal is: Whether WEBPADTM a composite of two descriptive terms creates a unitary mark with a separate non-descriptive meaning."

In arguing that WEBPAD is not merely descriptive when applied to wireless handheld computers for accessing a global computer network, applicant makes essentially five arguments. First, applicant argues at page 5 of its brief that there are many different meanings for the term "pad" both as a word and as an acronym. Applicant is entirely correct. The Examining Attorney's own evidence

shows that when used as an acronym, PAD can mean a number of different things besides "personal access device." For example, the acronym PAD also refers to "pressure actuated device" and "projected availability date." However, what applicant fails to understand is that the mere descriptiveness of a term is not judged in the abstract, but rather is judged in relation to the goods or services for

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which applicant seeks registration. In re Abcor Development Corp., 588 F.2d 811, 200 USPQ 215, 218 (CCPA 1978); In re Omaha National Corp., 819 F.2d 1117, 2 USPQ2d 1859, 1861 (Fed. Cir. 1987). When the term PAD is used in connection with wireless handheld computers for accessing a global computer network, purchasers of such devices would not think of a pressure actuated device, nor would they think of the other definitions of the word "pad" suggested by applicant at page 5 of its brief such as "sheets of blank paper fastened together at one edge" or a "guard for the leg and ankle in sports." When the term PAD is used in connection with wireless handheld computers for accessing a global computer network, the

term PAD would immediately be viewed as an acronym meaning "personal access device." Likewise, when used in conjunction with wireless handheld computers for accessing a global computer network, the term WEB would immediately bring to mind this global computer network. Indeed, as previously noted, applicant has conceded at page 1 of its Motion for Reconsideration "that the prefix of its mark refers to the World Wide Web."

Second, at page 7 of its brief applicant cites the case of In re Colonial Stores, Inc., 394 F.2d 549, 157 USPQ 382

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(CCPA 1968) where the Court held that the mark SUGAR & SPICE was not merely descriptive of bakery goods because it also had a second meaning, namely, a portion of a well known children's nursery rhyme. However, when applied to wireless handheld computers for accessing a global computer network the term WEBPAD has no double meaning. It readily informs consumers that applicant's goods are personal access devices to access the web (i.e. the World Wide Web).

Third, applicant argues at page 2 of its brief that

it was the first company to use the term WEBPAD, and that the vast majority of stories made of record by both applicant and the Examining Attorney use WEBPAD in a trademark manner to refer to applicant's product.

However, there are a number of stories where the term WEBPAD is used in a descriptive manner to refer to the products of other companies. The mere fact that applicant was the first user of the term WEBPAD and that most uses of this term refer to applicant's product does not mean that the term is not merely descriptive in that it forthwith conveys an immediate idea of the qualities or characteristics of applicant's goods. If applicant is of the belief that most users of the term WEBPAD have now come to view this term as a trademark

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referring to applicant's particular wireless handheld computers for accessing a global computer network, applicant is entirely free to seek to register this term pursuant to the provisions of Section 2(f) of the Trademark Act by proving that the term WEBPAD had achieved a secondary meaning referring primarily to applicant's particular products.

Fourth, at pages 6 and 7 of its brief, applicant argues that competitors do not need to use WEBPAD to describe their products because, according to applicant, there are other descriptive terms such as "set-top boxes"; "internet access devices"; "mobile computers"; or "wireless web access devices." The fact that there are other terms which may be descriptive of applicant's goods does not mean that WEBPAD is not likewise merely descriptive of applicant's goods.

Finally, applicant argues at pages 4-8 of its reply brief that there are "numerous recent third-party registrations in Class 9 that comprise the prefix WEB with a descriptive term. These registrations are no less descriptive of their associated goods than is applicant's mark." Three comments are in order. First, while we will not discuss individual third-party registrations, it appears

clear that numerous of these third-party registrations involve marks which are at most suggestive and not merely descriptive of their respective goods. Second, even if some of these third-party registrations involve marks

which were merely descriptive and which were registered without resort to the provisions of Section 2(f), this does not mean that applicant is likewise entitled to register a mark which is merely descriptive of its goods. While the PTO strives for uniform treatment, it does not always achieve this goal. Moreover, it need hardly be said that this Board is not bound by the actions of Examining Attorneys if they allowed third-party registrations which were merely descriptive to be registered without resort to Section 2(f). Finally, while applicant does not articulate this argument, if applicant at a later time were to argue that the existence of these third-party registrations consisting of various WEB marks somehow has caused consumers to view WEB marks, including WEBPAD, as trademarks, this argument would be without merit. Consumers are totally unaware of what is registered with the PTO. See Smith Brothers v. Stone Manufacturing, 476 F.2d 1004, 177 USPQ 462, 463 (CCPA 1973) ("But in the absence of any evidence showing the extent of

in use, they [the third-party registrations] provide no basis for saying that the marks so registered have had, or may have, any effect at all on the public mind ...").

One concluding comment is in order. At page 8 of its brief and again at page 8 of its reply brief, applicant correctly argues that any doubt on the issue of mere descriptiveness should be resolved in its favor. Suffice it to say that based upon this record, we have no doubt that consumers seeing the term WEBPAD on wireless handheld computers for accessing a global computer network would immediately understand that the term WEB refers to this global computer network (which applicant admits) and that the term PAD would be understood as an acronym meaning personal access device (again, a point which applicant admits).

Decision: The refusal to register is affirmed.